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| 09/835,158      | 04/13/2001  | Charles Walch        | 41936/24734         | 3857             |

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EXAMINER

HAQ, NAEEM U

ART UNIT PAPER NUMBER

3625

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/835,158

Applicant(s)

WALCH ET AL.

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicants' preliminary amendment, paper number 4, filed on April 13, 2001. Claims 36-398 have been cancelled. Claims 1-35 are pending and will be considered for examination.

### ***Specification***

The specification is objected because:

Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

In the present case, claims 1-5 on page 22 do not commence on a separate sheet. Appropriate correction is required.

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required. The Abstract and the claims are not double spaced.

### ***Claim Objections***

Claims 1-5 on page 22 and claims 1-5 on page 23 are objected to because of the following informalities: Theses claims have been numbered incorrectly. Claims 1-5 on page 23 should be renumbered to claims 6-11 respectively. Likewise claims 7-35 on

Art Unit: 3625

pages 24-28 should be renumbered to claims 12-40 respectively. Appropriate correction is required.

Claims 6-11 on page 23 are objected to under 37 CFR 1.75 as being substantial duplicates of claims 1-5 on page 22. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 and 19-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "local area" in claims 1, 6, 10, 19, 24, 28, and 32 is a relative term which renders the claim indefinite. The term "local area" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3625

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4, 6, 8-13, 15, 16, 17, 19-22, 24-26, 28-30, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US 5,960,411) in view of Yamada (US 6,336,100 B1).**

Referring to claims 1, 6, 9, 10, 15, 16, 19, 24, 28, 32, Hartman teaches a method and system of delivering consumer items comprising:

- recording a current purchase order of the consumer (column 2, lines 51-62; column 5, line 66 – column 6, line 1);
- selecting at least one item for the current purchase order from an Internet web page (column 3, line 31 – column 5, line 26);
- aggregating and bundling one or more items on the current purchase order from at least one merchandiser (column 5, lines 27-55);
- storing data identifying at least one item designated by a consumer as preferred, said data being retained for a time beyond a delivery of a current purchase order (column 5, line 66 – column 6, line 1).

Hartman does not teach retaining items at an errand center storefront for retrieval by said consumer. However, Yamada teaches this limitation (column 3, line 6 – column 4, line 15). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Yamada into the method and system of Hartman. One of ordinary skill in the art would have been motivated to do so in order to avoid redeliveries, as taught by Yamada. Hartman does not teach

scanning a unique product code for entering onto the current purchase order data identifying at least one item. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to allow a user to scan a UPC to identify a product for purchase. Applicant has not disclosed that scanning provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicants' invention to perform equally well with selection method and system Hartman because both allow a user to identify a particular item for purchase. Therefore, it would have been obvious to one of ordinary skill in this art to modify Hartman to obtain the invention as specified in the claims. Finally, Hartman does not explicitly teach a merchant within a local area or beyond the local area. However, as noted above, these limitations are indefinite. Moreover, Hartman teaches that his merchant is an online merchant. Therefore Hartman's merchant is not bound by any geographical limitations and can be both local as well as non-local.

Referring to claims 2, 11, 20, 25, 33, Hartman teaches that the selecting is from the Internet web page of at least one merchant (column 3, line 31 – column 7, line 23).

Referring to claims 3, 4, 8, 12, 13, 17, 21, 22, 26, 29, 30, 34, Hartman and Yamada do not teach that a local courier performs the aggregating and delivering, or that the errand center storefront is a kiosk. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to have a local courier aggregate and delivery the items as well as to have a kiosk as the errand center. Applicant has not disclosed that these features provide an advantage, are used for a

Art Unit: 3625

particular purpose or solve a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicants' invention to perform equally well with any courier and the delivery center of the cited prior because the steps of the method and elements of the system are not affected by who performs the delivery or whether or not the storefront is a kiosk. Therefore, it would have been obvious to one of ordinary skill in this art to modify the cited prior art to obtain the invention as specified in the claims.

**Claims 5, 7, 14, 18, 23, 27, 31, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US 5,960,411) in view of Yamada (US 6,336,100 B1) and further in view of Kargman (US 2003/0158790 A1).**

The cited prior art does not teach a subscription data structure automatically entering recurrent purchase orders items designated by the consumer for periodic delivery at periods designated by the consumer, without any further action being necessary by the consumer after the consumer designates the item and delivery period for the subscription item. However, Kargman teaches this limitation (page 1, paragraph [0011] – page 2, paragraph [0014]; page 2, paragraphs [0022]-[0024]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the features of Kargman into the method and system of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to improve the speed and efficiency of conducting periodic commercial transactions on the Internet, as taught by Kargman (page 1, paragraph [0006]).

Art Unit: 3625

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

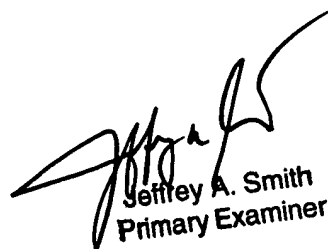
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

May 13, 2004



Jeffrey A. Smith  
Primary Examiner